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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057058
Party	Defendant Mormax, Inc.
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Attachments	FINAL Answer 06192013.pdf(41234 bytes )

Attorney Docket No.: 90656-001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Fifty-Six Hope Road Music Limited,  Petitioner,  v.  Mormax, Inc.,  and  Island Food & Fun, Inc.	Cancellation No.: 92057058  Registration No.: 3225517
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Commissioner for Trademarks  
ATTN: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**ANSWER TO PETITION FOR CANCELLATION**

Mormax, Inc. (“Mormax”), a corporation organized and existing under the laws of the State of Wisconsin with its principal address at PO Box 68, Lake Delton, WI 53940, and Island Food & Fun, Inc. (“Island Food & Fun”), a corporation organized and existing under the laws of the State of Wisconsin with its principal address at PO Box 68, Lake Delton, WI 53940 answer the Petition for Cancellation of Fifty-Six Hope Road Music Limited (“Petitioner”), as follows:

1. Admit that Mormax, Inc. applied on November 3, 2003 to register a mark containing the words MARLEY'S A TASTE OF THE CARIBBEAN, on an intent to use basis. Deny the remaining allegations of paragraph "1" and affirmatively assert that the application in question originally claimed standard characters; that the description set forth in paragraph "1" is not the description set forth in the original application; that no class was specified in the application; and that the Serial Number alleged in paragraph "1" is not the Serial Number of the application.
2. Admit the allegations set forth in paragraphs "2," "10," "29," and "34."
3. Admit the allegation set forth in paragraph "3" that Registration No. 3225517 issued on April 3, 2007, pursuant to standard USPTO procedure. Expressly deny any and all allegations that either Mormax or Island Food & Fun engaged in misrepresentation or fraud on the trademark office.
4. Deny the allegations set forth in paragraphs "4," "5," "6," "7," "8," "9," "13," "14," "27," "28," "30," "31," "32," "33," "35," "36," "37," "38," and "39."
5. Admit the allegations set forth in paragraph "11" that Morhel, LLC was organized in the State of Wisconsin on June 16, 2000 and that Morhel, LLC filed an application for state trademark registration with the Wisconsin Secretary of State on June 28, 2000; and affirmatively assert that the public records pertaining to both occurrences speak for themselves.

6. Deny the allegation set forth in paragraph “12” that Mormax was formed two years prior to July 2000; repeat the admission that Morhel, LLC was organized in the State of Wisconsin on June 16, 2000; and affirmatively assert that the Statement of Use submitted in connection with the challenged registration speaks for itself.
7. Deny knowledge or information sufficient to form a belief as to the truth of the allegation set forth in paragraph “15” that the design registered in connection with Petitioner’s TUFF GONG registration is an image of Bob Marley. With regard to the remaining allegations set forth in paragraph “15” admit that Petitioner has attached copies of what appear to be United States trademark registrations; deny knowledge or information sufficient to form a belief as to the current status of any of said registrations; and deny the relevance of any of said registrations.
8. Deny knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraphs “16,” “17,” “18,” “20,” “21,” “22,” “23,” “24,” “25,” “26,” and “40.”
9. Deny (as impossible and misleading) the allegation set forth in paragraph “19” that Petitioner first used the mark BOB MARLEY at least as early as 1970 for “downloadable ring tones for cell phones; and digital music downloadable from the Internet” and affirmatively assert that, upon information and belief, Petitioner did not exist in 1970 and,

in any event, that neither cell phones nor a publicly-available Internet existed in 1970. Expressly deny all other allegations set forth in paragraph “19.”

10. Expressly deny any and all allegations of the Petition that have not been affirmatively admitted herein.

#### AFFIRMATIVE DEFENSES

11. Subject to the Board’s resolution of Registrant’s pending motion to substitute Island Food & Fun as the defendant in this proceeding, both Mormax and Island Food & Fun assert and reserve all rights in connection with each and every defense set forth herein. References to “Registrant” shall refer to either Mormax and/or to Island Food & Fun, as required by the eventual ruling on the motion to substitute.

12. Petitioner has failed to state a claim upon which relief can be granted.

13. Registrant did not commit fraud on the office.

- a. None of the factors set forth in *In re Bose Corp.* (580 F.3d 1240 [Fed. Cir. 2009]) are present in this case.
  - i. Registrant (in stating its dates of first use) did not make a false representation.

- ii. Even if Registrant's stated dates of use were false (which Registrant expressly denies), such information was not material to registrability of the mark (see argument in the next paragraph).
  - iii. Even if Registrant's stated dates of use were false (which Registrant expressly denies), Registrant lacked knowledge of the falsity of the representation.
  - iv. Even if Registrant's stated dates of use were false (which Registrant expressly denies), Registrant had no intent to deceive.
- b. Registrant denies that its stated dates of first use were incorrect or in any way a misstatement. However, even if Petitioner's allegations on this point were correct, they are irrelevant.
  - i. The application that eventually matured into Registration No. 3225517 was filed as an intent-to-use application.
  - ii. For purposes of registration (which is the only appropriate inquiry in a cancellation proceeding), the relevant factors are the date of filing (November 3, 2003) and the applicant's sworn statement that, as of the Statement of Use date, the mark was in use in commerce in connection with all the services identified in the Notice of Allowance.
- c. Without prejudice to any other defenses set forth herein, Registrant expressly reserves all rights to claim tacking.

14. Petitioner's claim that Registrant is not the owner of the mark is not properly before the Board.

- a. Registration No. 3225517 issued on April 3, 2007.
  - b. This proceeding was commenced on April 8, 2013.
  - c. Non-ownership of a mark at the time of registration cannot be asserted against a registration more than five years old (*Kemin Industries, Inc. v Watkins Products, Inc.*, 192 USPQ 327 (TTAB 1976)).
15. Without prejudice to any other defenses set forth herein, Registrant expressly asserts that it was the owner of the mark at the time of application and registration.
16. Petitioner's claims regarding false association with Bob Marley should be dismissed for deficiency in pleading.
- a. Petitioner seeks cancellation based on "false association" with Bob Marley. This term does not appear in the statutory provisions setting forth permissible grounds for cancellation.
  - b. The challenged registration is more than five years old.
  - c. 15 USC §1064(3) references 15 USC §1052(a); 15 USC §1052(a) employs the term [false suggestion of a] "*connection* with persons, living or dead...."
  - d. "False association" and "false suggestion of a connection" are not synonymous.
  - e. Petitioner has failed to plead a permissible ground for cancellation for a registration more than five years old.
17. Without prejudice to any other defenses set forth herein, and assuming without admitting that Petitioner intended its claim to be one for false suggestion of a connection pursuant

to 15 USC §1052(a): Petitioner's claims should be dismissed on equitable grounds of laches and estoppel.

- a. Equitable defenses are available against claims to cancellation based on false suggestion of a connection (*Treadwell's Drifters, Inc. v Marshak*, 18 USPQ2d 1318 [TTAB 1990]).
- b. Petitioner had actual notice of Registrant's adoption of the mark at least as early as August, 2005.
  - i. Petitioner's then-counsel, Timothy J. Ervin, sent a cease and desist letter to Registrant dated August 10, 2005; a follow-up letter dated September 22, 2005; another dated October 26, 2005; and another dated November 8, 2005.
  - ii. Petitioner's counsel then forwarded to Registrant a draft complaint, on December 8, 2005.
  - iii. Upon information and belief, Petitioner took no further action in connection with Registrant's use of the mark.
- c. Petitioner is charged with constructive notice of the challenged registration as of its publication for opposition (January 31, 2006).
- d. Petitioner did not bring an opposition proceeding during prosecution of the challenged registration.
- e. The instant petition for cancellation was filed on April 8, 2013; nearly eight years after Petitioner had actual notice of Registrant's adoption of the mark.
  - i. It is well established that an eight year delay (in commencing a trademark cancellation proceeding) demonstrates lack of diligence and is "unusually



long by any standard” (*Pro-Football, Inc. v Harjo*, 567 F. Supp. 2d 46, *affd* 565 F.3d 880, *cert denied* 558 U.S. 1025, 130 S. Ct. 631, 175 L. Ed. 2d 480 [2009]).

- f. During the years of Petitioner’s inaction, Registrant expended time, effort and considerable amounts of money in building its business under the challenged mark. Registrant created a valuable business and related goodwill under the mark, while Petitioner, a sophisticated party represented by counsel, did nothing.
  - g. Petitioner overtly lulled Registrant into believing that Petitioner would not act; Registrant relied to its detriment on such belief.
  - h. Registrant would suffer severe trial and economic prejudice, should the registration be cancelled at this late date.
18. Without prejudice to any other defenses set forth herein, Petitioner’s claims regarding false association with Bob Marley are a veiled attempt to cancel based on likelihood of confusion, which claim cannot be asserted against a registration more than five years old; and/or they constitute claims based on rights of privacy and/or publicity, which are not within the Board’s jurisdiction.
19. Without prejudice to any other defenses set forth herein, Registrant expressly asserts that its adoption and use of the mark does not create a false suggestion of a connection with Bob Marley.
- a. Petitioner has not made any claims with regard to elements of the challenged design registration other than the word “Marley.”

- b. The challenged registration must be considered as a unified whole.
- c. “Marley” is not a name solely associated with Petitioner.
- d. The challenged registration does not point uniquely and unmistakably to Petitioner.
- e. Numerous other registrations including the word “Marley,” owned by parties other than Petitioner, co-exist on the Principal Register; many other common law uses exist.

20. Petitioner has pleaded and attached numerous registrations that are irrelevant to the instant proceeding.

- a. Most of the attached registrations issued well after Registration No. 3225517; and most are for goods and services completely unrelated to Registrant’s services.
  - i. Registrant reserves the right to challenge all of the alleged registrations Petitioner attempts to plead, on all grounds. Without limitation, however, Registrant specifically notes that the following alleged registrations issued after Registration No. 3225517:
    - 1. 4044264
    - 2. 4044265
    - 3. 4044263
    - 4. 4044262
    - 5. 4044261
    - 6. 4044260
    - 7. 4044259

8. 4044258
9. 4044257
10. 4044256
11. 3778736
12. 4187013
13. 3871574
14. 4158045
15. 4242186
16. 4150381
17. 4222035
18. 4222036
19. 3849342
20. 3934085

- b. Further to Registrant's argument on the issue of laches: Registrant notes that in the course of prosecuting the above-referenced applications for registration, Petitioner still failed to take any action in connection with the challenged registration.
- c. Petitioner has failed to comply with 37 CFR §2.122(d). Accordingly, the alleged registrations attached to the petition should not be received in evidence.
- d. Listing and attaching so many irrelevant registrations constitutes presentation for an improper purpose in violation of Rule 11 of the Federal Rules of Civil Procedure.

21. Petitioner lacks standing to bring this cancellation proceeding.

- a. Upon information and belief, Petitioner has entered into trademark licensing agreements with numerous entities, including but not limited to Zion Rootswear, LLC, Universal Music Group, and others; it is also a matter of public record that Petitioner has been involved in numerous trademark-related disputes, including with other relatives of Bob Marley. Registrant reserves the right to discovery for the purpose of ascertaining whether the estate documents of Bob Marley and/or outstanding agreements, decrees or proceedings serve to divest Petitioner of standing to challenge Registration No. 3225517.

WHEREFORE, Registrant respectfully requests that the Board dismiss the petition in all respects, and leave Registration No. 3225517 undisturbed.

Respectfully submitted,

/elizabeth t russell/

Attorney for Mormax, Inc. and for Island Food & Fun, Inc.

Dated: June 19, 2013

The above is my electronic signature, personally entered by me in accordance with the requirements of 37 C.F.R. §2.193(c)

Elizabeth T Russell  
49 Kessel Court, Suite 200  
Madison, WI 53711  
Telephone: 608-285-5007

## **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing ANSWER TO PETITION FOR CANCELLATION was served on Petitioner by mailing a copy by First Class Mail, postage prepaid, to Petitioner's counsel at the following address on this 19th day of June, 2013:

Jill M. Pietrini  
SHEPPARD MULLEN RICHTER & HAMPTON LLP  
1901 Avenue of the Stars, Suite 1600  
Los Angeles, CA 90067-6017

/elizabeth t russell/

The above is my electronic signature, personally entered by me in accordance with the requirements of 37 C.F.R. §2.193(c)

Elizabeth T Russell  
49 Kessel Court, Suite 200  
Madison, WI 53711  
Telephone: 608-285-5007

## **CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that a true and correct electronic copy of the foregoing ANSWER TO PETITION FOR CANCELLATION is being filed with the Trademark Trial and Appeal Board via ESTTA on this 19th day of June, 2013.

/elizabeth t russell/

The above is my electronic signature, personally entered by me in accordance with the requirements of 37 C.F.R. §2.193(c)

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